

REMARKS

Claims 1-18 are pending in the Application and are now presented for examination.  
Claims 10 and 12 have been amended. Claims 15-18 have been added. No new matter has been added.

Claims 1, 15 and 17 are independent.

*Drawing Objection*

Page 2 of the Office Action states the drawings are objected to because the “primary portion” and “secondary portion” recited in Claim 10 are not shown in the drawings. Applicants have amended Claim 10 to remove the “primary portion” and “secondary portion” claim language. As such, Applicants believed the objection has been addressed and respectfully request the withdrawal of the objection.

*Claim Objection*

Page 2 of the Office Action states that Claim 10 is objected to “primary inlet” should be rewritten as a “primary inlet port.” Applicants have removed the “primary inlet” claim language from Claim 10. As such, Applicants believed the objection has been addressed and respectfully request the withdrawal of the objection.

*Patentability Under 35 U.S.C. § 112*

On page 3 of the Office Action, Claim 10 is rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, page 3 of the Office

Action states that the phrase “the first volume has a primary portion and a secondary portion,” in Claim 10, is vague and indefinite. Applicants have removed the phrase from Claim 10. As such, Applicants believe the rejection has been addressed and respectfully request the withdrawal of the rejection.

***Patentability Under 35 U.S.C. § 103***

The claims relate to a respirator that includes an outer mask. The outer mask defines a first volume. The respirator includes an oronasal mask that defines a second volume. The oronasal mask is positioned within the first volume. A primary filter is fixed to the outer mask and a secondary filter is positioned within the first volume such that the secondary filter filters air traveling from the first volume to the second volume.

For example, Applicants’ arrangement “is such that the incoming air...flows across the top of the oronasal mask, and thus across visor 3” before entering the oronasal mask, thereby allowing effective demisting of the visor (¶¶ [0049] and [0050]). Thus, Applicants’ arrangement allows effective demisting of the visor while using a minimal amount of conduit to guide inhaled air (FIG. 1).

**Claims 1-3 and 12-14**

On page 4 of the Office Action, Claims 1-3 and 12-14 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Richardson et al. (U.S. Patent No: 7,013,891, hereinafter referred to as “Richardson”) in view of Tayebi (U.S. Patent No: 4,945,907, hereinafter referred to as “Tayebi”). Applicants respectfully traverse the rejection.

Independent Claim 1

Independent Claim 1 recites, in part, “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume.” Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Independent Claim 1.

*The Office Action uses impermissible hindsight to modify Richardson with Tayebi*

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness” (M.P.E.P. § 2142). “Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so” (M.P.E.P. § 2143.01). However, “any judgment of obviousness” cannot include “knowledge gleaned only from applicant’s disclosure” (M.P.E.P. § 2145). The Office Action does just that by using knowledge gleaned only from Applicants’ disclosure as a roadmap for modifying Richardson with Tayebi (M.P.E.P. § 2145).

For example, page 5 of the Office Action adds Tayebi’s internal filter liner 17, which is sandwiched with external filter liner 18 at an inlet port, within Richardson’s conduits, i.e., “it would have been obvious...to provide Richardson’s conduit with a filter liner as taught by Tayebi” (Page 5 of Office Action). There is simply no motivation for placing Tayebi’s internal filter liner 17, which is sandwiched with external filter liner at an inlet port to the mask as a whole, within Richardson’s conduit, absent using “knowledge gleaned only from applicant’s disclosure” (M.P.E.P. § 2145). As such, the Office Action is inappropriately using impermissible hindsight to combine Richardson and Tayebi in order to specifically place Tayebi’s internal filter liner 17 into an internal location within Richardson’s conduits.

Accordingly, the Office Action uses impermissible hindsight to combine Richardson and Tayebi, which cannot support a *prima facie* case of obviousness. Applicants respectfully request the withdrawal of the rejection.

*Richardson and Tayebi fail to disclose or suggest the features of Claim 1*

Even assuming the combination of Richardson and Tayebi is proper (which Applicants respectfully assert is not the case), Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 1.

For example, Claim 1 recites that the second filter “filters air traveling from the first volume to the second volume.” Page 5 of the Office Action states that “Richardson...lacks a secondary filter to provide filter gas passing from the main volume to the secondary volume....” Applicants agree that Richardson fails to disclose or suggest the above cited features of Claim 1.

Page 5 of the Office Action cites Tayebi’s filter liner (17) in FIG. 3 as allegedly curing the deficiencies of Claim 1. Tayebi does not. As an initial matter, page 5 of the Office Action misinterprets what Tayebi actually teaches. The Office Action’s cited portions of Tayebi merely describe using a single filter, i.e., internal filter liner 17, to filter air entering the mask 10 (FIG. 3; col. 9, line 46 to col. 10, line 4). Tayebi’s single filter simply does not disclose using a second filter, let alone a second filter filtering air traveling specifically from the first volume to the second volume.

Tayebi merely describes a single filter mask in which a “filter liner 17 [is] mounted in the interior of mask shell 11 behind all of holes 12 to filter inhaled air passing through holes 12” (col. 9, lines 3-13). Certainly, Tayebi’s **single filter**, as illustrated in FIG. 3, does not teach or suggest Applicants’ **second** filter. Moreover, Tayebi’s filter liner 17 that filters air being inhaled

into the mask does not disclose or suggest a “secondary filter filtering air traveling from the first volume to the second volume” as recited in Claim 1.

At most, Tayebi describes “self adhesive filter liners 17 and 18 may be attached” to mounting pieces 33a and 33b via self adhesive strips 32 (col. 11, line 57 to col. 12, line 1). Tayebi describes filter liner 18 as an external filter liner and filter liner 17 as an internal filter liner in which both filter liners are configured to form a sandwich configuration at inlet port to filter traveling into the mask, i.e., filter liners 17 and 18 are specifically placed at the inlet ports of mask 10 (FIG. 7; col. 11, line 54 to col. 12, line 22). In other words, Tayebi’s sandwiched internal and external filters (17, 18) that are placed at the inlet ports of mask 10 simply filter air traveling into the mask. Absent from Tayebi’s description directed to placing an internal filter liner 17, sandwiched with external filter liner 18 at the inlet ports of a mask, is placing the filter within the first volume to filter air “traveling from the first volume to the second volume” as recited in Claim 1.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 1, and Applicants respectfully request the withdrawal of the rejection to Claim 1.

Claim 2, 3 and 12-14

Claim 2, 3 and 12-14 are each dependent either directly or indirectly from independent Claim 1, discussed above. Claims 2, 3 and 12-14 are believed patentable at least by virtue of being dependent from an independent claim that is believed to be allowable. Further, these claims recite additional limitations which, in conformity with the features of their corresponding independent claim, are not disclosed or suggested by the art of record. However, the individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

Claims 4, 5 and 8-11

On page 7 of the Office Action, Claims 4, 5 and 8-11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Richardson et al. (U.S. Patent No: 7,013,891, hereinafter referred to as “Richardson”) and Tayebi (U.S. Patent No: 4,945,907, hereinafter referred to as “Tayebi”) and further in view of Kiefer et al. (U.S. Patent No: 7,261,104, hereinafter referred to as “Kiefer”). Applicants respectfully traverse the rejection.

Claims 4, 5 and 8-11 depend from Claim 1. As explained above, Richardson and Tayebi fail to teach or suggest at least one element of Claim 1. Keifer fails to teach or suggest the elements of Claim 1 not disclosed or suggested by Richardson and Tayebi. For example, Keifer fails to teach or suggest “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume,” i.e., Keifer does not teach these features as “Keifer is [cited by the Office Action] only to teach a one way valve” (Page 12 of the Office Action).

In contrast to Claim 1, Keifer describes a first embodiment (10) that includes inhalation ports 110 each having filtering element connectors 400 (FIGS. 1A, and 1C, col. 5, lines 17-35). Keifer also describes a second embodiment (10') in which an inhalation port 274 cooperates with filtering cartridge 800 (FIG. 2C). There is simply no “secondary filter filtering air traveling from the first volume to the second volume” as claimed. Thus, each filter element in Keifer (400) operates as a primary filter that receives and filters outside air before the air passes into the mask. Thus, Keifer fails to teach or suggest “the secondary filter is provided to filter gas passing from the main volume to the secondary volume” as recited in Claim 1.

Therefore, Richardson, Tayebi and Keifer, whether considered individually or in combination, fail to teach or suggest at least one element of Claim 1, from which Claims 4, 5 and

8-11 depend. Hence, Claims 4, 5 and 8-11 are allowable, at least by virtue of their dependency from an allowable Claim.

Claim 6 and 7

On page 9 of the Office Action, Claims 6 and 7 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Richardson et al. (U.S. Patent No: 7,013,891, hereinafter referred to as “Richardson”) and Tayebi (U.S. Patent No: 4,945,907, hereinafter referred to as “Tayebi”) and further in view of Bee (U.S. Patent No: 7,089,931, hereinafter referred to as “Bee”). Applicants respectfully traverse the rejection.

Claims 6 and 7 depend from Claim 1. As explained above, Richardson and Tayebi fail to teach or suggest at least one element of Claim 1. Bee fails to teach or suggest the elements of Claim 1 not disclosed or suggested by Richardson and Tayebi. For example, Bee fails to teach or suggest “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume,” i.e., Bee does not teach these features and “is [cited by the Office Action] only to teach a one way valve within the inlet duct to the oronasal mask” (Page 12 of the Office Action).

In contrast to Claim 1, Bee describes a respirator that allows inhaled air to be “drawn via ducts 8, 9 from the outside 7, and over the eyepiece of the ocular mask 2, before being drawn into the oronasal mask 3” (col. 3, lines 19-21). Bee’s respirator is not the same as “a secondary filter positioned within the first volume, the secondary filter filtering air traveling from the first volume to the second volume” as recited in Claim 1. Thus, Bee fails to teach or suggest “the secondary filter is provided to filter gas passing from the main volume to the secondary volume” as recited in Claim 1.

Therefore, Richardson, Tayebi and Bee, whether considered individually or in combination, fail to teach or suggest at least one element of Claim 1, from which Claims 6 and 7 depend. Hence, Claims 6 and 7 are allowable, at least by virtue of their dependency from an allowable claim.

New Independent Claim 15

Independent Claim 15 recites, in part, “a secondary filter positioned within the first volume, the secondary filter configured to filter air traveling around the oronasal mask and across the visor.” For example, Applicants’ arrangement “is such that the incoming air...flows across the top of the oronasal mask, and thus across visor 3” before entering the oronasal mask, thereby allowing effective demisting of the visor (¶¶ [0049] and [0050]). Thus Applicants’ arrangement allows effective demisting of the visor while using a minimal amount of conduit to guide inhaled air (FIG. 1). Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 15.

Richardson merely describes filter canister 7 attached to the ocular mask 50 that filters inhaled air and discharges “this clean air, by way of a flexible duct (not shown), into the cavity 4 to [maintain] a positive air pressure with respect to the ambient atmosphere 9” (col. 7, lines 38-42; col. 7, lines 3-10). Richardson’s external filter canister does not disclose or suggest “a secondary filter positioned within the first volume”, i.e., Richardson’s filter canister 7 is not positioned within the Office Action’s interpreted first volume as illustrated on page 4 of the Office Action. Moreover, Richardson’s filter canister that filters air traveling into the Office Action’s interpreted first volume does not “filter air traveling around the oronasal mask and across the visor” as recited in Claim 15.

Tayebi fails to cure the deficiencies of Richardson. *Similar to Richardson*, Tayebi merely describes filtering air as it travels from the outside the mask to the inside the mask (emphasis added). In particular, Tayebi describes an internal filter liner 17 and external filter liner 18 in which “self adhesive filter liners 17 and 18 may be attached” to mounting pieces 33a and 33b via self adhesive strips,” i.e., placed in a sandwich configuration to filter air traveling into face mask 10 (col. 11, line 57 to col. 12, line 1). Tayebi’s external and internal filter liners simply do not disclose or suggest a “filter configured to filter air traveling around the oronasal mask and across the visor” as recited in Claim 15. As such, Tayebi fails to disclose or suggest the above cited features of Claims 15.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 15. Hence, Claim 15 is allowable for at least this reason.

#### New Independent Claim 17

Independent Claim 17 recites, in part, that “at least a portion of the filter conduit being positioned against the inner surface of the outer mask.” For example, Applicants’ arrangement “is such that the incoming air...flows across the top of the oronasal mask, and thus across visor 3” before entering the oronasal mask, thereby allowing effective demisting of the visor (¶¶ [0049] and [0050]). Thus Applicants’ arrangement allows effective demisting of the visor while using a minimal amount of conduit to guide inhaled air (FIG. 1). Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 17.

As discussed above with respect to Claim 15, Richardson merely describes outer mask 3, ocular mask 50, filter canister 7 and inlet 5 (FIG. 4). Richardson illustrates using tube-like

structures to connect inlet 5, filter canister 7, ocular mask 50, oronasal mask 2 and outlet valve 18 together in order to funnel air to and from these elements (FIG. 4). Richardson's illustration of tube-like structures used to funnel air does not disclose or suggest that "at least a portion of the filter conduit [is] positioned against the inner surface of the outer mask." As such, Richardson fails to disclose or suggest the above cited features of Claim 17.

Tayebi fails to cure the deficiencies of Richardson. As discussed above with respect to Claim 17, Tayebi merely describes sandwiching internal and external filters (17, 18) and placing them at inlet ports of mask 10 to filter air traveling into the mask (emphasis added). Absent from Tayebi is a conduit let alone "at least a portion of the filter conduit [that is] positioned against the inner surface of the outer mask" as recited in Claim 17. As such, Tayebi fails to disclose or suggest the above cited features of Claim 17.

Accordingly, Richardson and Tayebi, whether considered individually or in combination, fail to disclose or suggest the above cited features of Claim 17, and Applicants respectfully request the withdrawal of the rejection to Claim 17.

For all of the above reasons, the claim rejections are believed to have been overcome placing Claims 1-18 in condition for allowance, and reconsideration and allowance thereof is respectfully requested.

The Examiner is encouraged to telephone the undersigned to discuss any matter that would expedite allowance of the present application.

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The Commissioner is hereby authorized to credit overpayments or charge payment of any additional fees associated with this communication to Deposit Account No: 502104.

Respectfully submitted,

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